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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,703	11/18/2003	Peter Tiesler	ZAHFRI P574US	5406
20210	7590	02/01/2005	EXAMINER	
DAVIS & BUJOLD, P.L.L.C. FOURTH FLOOR 500 N. COMMERCIAL STREET MANCHESTER, NH 03101-1151			BONCK, RODNEY H	
			ART UNIT	PAPER NUMBER
			3681	

DATE MAILED: 02/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

 <b>Office Action Summary</b>	<b>Application No.</b> 10/715,703	<b>Applicant(s)</b> TIESLER ET AL	
	<b>Examiner</b> Rodney H. Bonck	<b>Art Unit</b> 3681	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2003.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 16-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>02/05/04&amp;11/26/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

The following is a first action on the merits of application Serial No.10/715,703, filed November 18, 2003.

### ***Information Disclosure Statement***

Receipt is acknowledged of the Information Disclosure Statements (IDS) filed February 5, 2004 and November 26, 2004. The cited documents in the IDS of November 26, 2004 have been considered, and the U.S. Patent to Taniguchi et al., cited in the IDS of February 5, 2004, has been considered. The two German documents cited in the IDS of February 5, 2004 have not been considered because no copies of the documents were provided.

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: **52**. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the

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changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21, 22, 25, 27, 28, and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is no proper antecedent basis for "the sheet metal pieces", recited in claim 21. In claim 22, "the section of said clutch discs" lacks a proper antecedent basis. It is unclear whether the limitations after the word "particularly", line 2 of claim 22, are part of the claimed invention. Also, in claim 22, "said embossing" and "the end disc" lack a proper antecedent basis. In claim 25, "said end disc" lacks a proper antecedent. In claim 27, "said parts" has no proper antecedent, and it is unclear what is meant by the recitation "situated radially beneath said parts are axially overlapped." There is no antecedent basis for "said contact nubs", recited in lines 1-2 of claim 28. In claim 30, it is unclear whether the limitations after the word "particularly" are part of the claimed invention.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 16-19, 24, and 26-30, insofar as definite, are rejected under 35 U.S.C. 102(b) as being anticipated by Alfredsson(WO 01/42674 A1). Alfredsson discloses a clutch arrangement having two axially and radially adjacent multi-disc clutches. Inner discs 15 of the inner clutch are on inner disc carrier 16, and outer discs 12 of the outer clutch are on outer disc carrier 13. The inner discs 10 of the outer clutch and the outer discs 11 of the inner clutch are on common carrier 7. Each clutch has a separate actuating piston 18 and 25 that move in the same direction to actuate the clutches. The discs of the inner clutch are pressed against a guard ring (not numbered) that is secured in a receiving groove in the common carrier. The discs of the outer clutch are pressed against a contact section (not numbered) of the common carrier, which consists of a radially outward pointing end piece of the common disc carrier. The common disc carrier in Alfredsson is a sheet metal part. The contact section is a retaining ring secured in a groove of the carrier, and is thus an integral part of the final assembly. The method of forming the contact section is not patentably significant in these claims to the clutch arrangement. Since the contact section is a rigid part, it can be considered to be shaped so that stiffness is positively influenced as claimed, and it can be considered a contact ring, insofar as defined. The clutch arrangement of

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Alfredsson is for use in a transmission, which can be considered an automatic transmission or an automated selector transmission, insofar as the terms are defined.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alfredsson(WO 01/42674 A1) in view of Walker('043). The receiving groove in Alfredsson does not appear to have the claimed radial openings. Walker discloses a sheet metal clutch disc carrier wherein the retaining groove is formed with openings

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peripherally distributed around the carrier (see Figs. 4-6 of Walker). It would have been obvious to so form the retaining groove in Alfredsson, the motivation being to inexpensively produce the groove in a manner that resists spline deformation.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alfredsson(WO 01/42674 A1) in view of Morishita et al.('743). Alfredsson does not appear to provide the claimed contact nubs on the contact section. Morishita et al., however, provide a multi-disc clutch wherein the contact section (not numbered, but see Fig. 1) is provided with axially projecting contact nubs. It would have been obvious to provide such nubs in the Alfredsson device, the motivation being to center the force applied to the end disc.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kuhn et al.('695) is cited to show contact section 16 of a multi-disc clutch. Freidmann et al.('682) shows contact section 72 for a multi-disc clutch. Aschauer('270) is cited to show contact section 16 on inner carrier 18. Hiramatsu et al.('253), Dach et al.('727), Piret('605), Zaiser('393), and Johnson('985) show other clutch arrangements with a common disc carrier.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney H. Bonck whose telephone number is (703)-

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308-2904. The examiner can normally be reached on Monday-Friday 7:00AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor can be reached on (703)-308-0830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Rodney H. Bonck  
Primary Examiner  
Art Unit 3681

rhb  
January 26, 2005